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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,408	08/13/1999	CHRISTOPHER C. ANDREWS	ANDREWS-0080	3712
28960	7590	02/24/2005	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			FOSTER, ROLAND G	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/374,408	ANDREWS, CHRISTOPHER C.
	Examiner Roland G. Foster	Art Unit 2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 October 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-50 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

In the amendment, filed on October 07, 2004 (the "instant amendment"), the applicant argues for reconsideration of the examiner's prior 112<sup>th</sup>, 1<sup>st</sup> paragraph rejection (for failing to comply with the written description requirement) and the examiner's corresponding objection to the specification. In particular, the applicant argues that portions of the applicant's specification support the amendment, thus overcoming the examiner's 112<sup>th</sup>, 1<sup>st</sup> paragraph rejection (pages 14-16).

The applicant's arguments were deemed persuasive, except for the phrases "unique to the recorded audio file" and "directly accessible."

With respect an address "unique to the recorded audio file", the applicant argued that a "'corresponding' address is the same as a 'unique' address...." (page 15 of the instant amendment).

Applicant's argument was considered but not deemed persuasive. Applicant failed to disclose where the term "unique" was expressly disclosed in the original specification. Therefore, the plain meaning of "unique" is considered. "Unique" means having some quality of being the only one by plain meaning. In contrast, the disclosed term "corresponding" means to compare closely to, to be equivalent to, or parallel to, thus suggesting qualities that are dissimilar

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and even contradictory to the quality of uniqueness. Thus, by plain meaning these two terms diverge.

Therefore, a person of ordinary skill in the art at the time the application was filed would not have recognized that the inventor was in possession of the term "unique" as claimed because the portions of the specification that were pointed out by the applicant disclose terms that are substantially dissimilar and even have contradictory qualities, such as the term "corresponding."

With respect to the phrase "directly accessible" audio file, the applicant points to a portion of the specification, which stated that "when the corresponding address is accessed, the audio data within the recorded audio file is transmitted from the internet server to the accessing computer system for playback at that accessing computer system" (pages 14 and 15 of the instant amendment).

Applicant's argument were considered but not deemed persuasive. The feature in the specification that was pointed out by the applicant above at least expressly and minimally discloses a step of accessing. The specification also discloses other minimally described accessing steps (e.g., see page 4, lines 14-16, page 8, lines 17-22, and page 13, lines 12-14).

However, the applicant does not stop there. As discussed above, the basis for a 112, 1<sup>st</sup> paragraph rejection is the record as a whole, including the applicant's arguments. In the instant amendment, applicant argued that directly accessing a file must also mean excluding certain

other steps that may occur before the step of directly accessing the file via a hyperlink, such as gaining authorization and entering a file list command (page 29, last paragraph). Thus, a person logged onto a mailbox and staring at a list of hyperlinks that allow that person to directly access audio files (as in the prior art Bobo) could not be said to have "direct access" to those files according to the definition argued by the applicant, even though the person certainly does have direct access to those files at the current point in time. Indeed, the applicant argued that this more detailed and exclusive meaning of "directly" accessing is a part of the applicant's claimed invention that patentably distinguishes over the prior art. *Id.* However, the specification fails to expressly disclose that directly accessing a file means excluding any authorization steps or a list of messages steps that precedes it. Thus in view of the entire record, the applicant also has not pointed out how specification specifically support the matter introduced.

Therefore, a person skill in the art at the time the application was filed would not have recognized that the inventor was in possession of the term "directly accessible" as claimed in view of the disclosure of the application as filed.

On page 18 of the amendment, the applicant argued that it would "not have been obvious to add alternate embodiments (voice message reception station) of Choksi (U.S. 6,477,243) to the main embodiment (facsimile message reception station)" because "only the sender is notified that the voice message has been received; not other recipient" in contrast to the facsimile system disclosed in the main embodiment.

The applicant's arguments were considered but they are not deemed persuasive. Choksi concentrates on the facsimile message system in the main embodiment but then states "the present invention should in no way be limited thereby" and that "in addition to the above described embodiments, a...voice ...system configured in accordance with the present invention...." (col. 9, lines 33-41). Thus, a voice message system that fails to notify other recipients as does the facsimile messaging system (main embodiment) would not be "in accordance with the present invention" and would be limiting the present invention (main embodiment) contrary to the express teachings of Choksi. Thus, the applicant's arguments second-guess the express teachings of two inventors, Himanshu Choksi and Siva V. Kumar.

Further, one of ordinary skill in the art would have a very low skill level indeed if that person inspected a single patent such as Choksi but did not find it facially obvious to incorporate compatible features from one embodiment into the other embodiment patent, even ignoring the strong, express suggestions by Choksi to do so (as discussed above).

On page 29 of the amendment, the applicant argues that Bobo (U.S. 5,675,507) fails to disclose "directly" accessing the mailbox because the user has to "access the mailbox, then access a list of messages, and then...finally access the message."

The applicant's arguments were considered but they are not deemed persuasive. As discussed regarding the 112, 1<sup>st</sup> paragraph rejection above below, the applicant's original specification fails to support the claimed phrase "directly accessible" if that phrase is to be

interpreted as the applicant argues (e.g., excluding certain other steps that may occur before the step of directly accessing the file via a hyperlink, such as an authorization step and file listing steps).

The examiner's interpretation of the claimed phrase "directly accessible" is reasonably broad consistent with the applicant's specification. The applicant's specification minimally discloses an accessing step that is not to be confused with the separately claimed transmitting (playback) step. For example, the user can directly access the audio file by selecting the anchor (hyperlink) as consistent at several instances with the applicant's specification (e.g., see page 4, lines 14-16, page 8, lines 17-22, and page 13, lines 12-14), where the actual transmitting (playback) step involves both direct playback (transmitting the audio file to the accessing computer system for playback) and indirect playback (combining the audio file with another message and delivering the message to one or more specified locations) (page 8, lines 20-24). Similarly in Bobo, the user accesses the voice message (recorded audio file) on the computer system by selecting the anchor (col. 13, lines 5-33). The anchor (hyper-text link) points to address where the file (e.g., voice message) is stored (e.g., <A HREF=1.wav") (col. 8, lines 8-20, col. 12, lines 30-54, and col. 13, lines 1-33). A separate transmitting (playback) step then occurs.

Applicant argues on page 30 that Acharya (U.S. 6,408,296) does not teach or make obvious recording an audio file or associating a hyperlink with the recorded audio file.

Although the applicant's arguments were duly considered, they were not deemed persuasive. Applicant argues against the combination of Bobo and Acharya in a manner inconsistent with how the examiner actually combined the references. For example, the examiner expressly relied on Bobo to disclose associating a hyperlink (address) with the recorded file and even strongly suggesting that such an address would be unique (see page 16 of the last Office action). The examiner then relied on Acharya to teach the ability of the hyperlink (address) disclosed by Bobo to point to an address unique to the recorded file disclosed by Bobo (see page 17 of the last Office action).

Applicant argues on page 39 that in Uppaluru "there is no indication" that the audio files are transmitted to a conventional web browser.

Although the applicant's arguments were duly considered, they were not deemed persuasive. Applicant's arguments are directed to a feature (transmitting audio files to a conventional web browser) that is not claimed. The claims only require that the audio files are transmitted to a "computer system", which reads on the voice browser of Uppaluru, which in turn sends the audio files to the user via a telephone connection. The term "computer system" is a broad term that can be reasonably interpreted to include more than just a "web browser".

The remaining applicant arguments are conclusory, clearly taught by the prior art, previously answered in the extensive prosecution history for this case, or derive from the

arguments already addressed above (including arguing against a 103 combination of references in a manner inconsistent with how the examiner actually combined the references).

For the above reasons, the following rejections are repeated except where any new grounds of rejection are due to the applicant's amendment to the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The following 112, 1<sup>st</sup> paragraph rejection is based on the record as a whole, including the amendments and arguments discussed below (MPEP § 2163.04).

The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (i.e., new matter). If an applicant amends the specification, an issue of new matter will also arise if the content of the amendment is not described in the application as filed. See MPEP § 608.04 and § 2163.06.

In the instant case, an amendment, filed on April 12, 2004 as Paper No. 26, introduced limitations into the specification in response to an objection set forth by the examiner in the final rejection, mailed on Feb. 11, 2004 as Paper No. 25. Specifically, the examiner objected to the specification has not providing antecedent basis for the claimed subject matter. Further, certain portions of this claimed subject matter were not set forth in the originally presented claims (e.g., "independently accessible address", "separately and directly accessible", "unique to the recorded audio file", and "by anyone") and thus cannot be considered as part of the original specification. The examiner suggested making an "appropriate amendment to the specification" (Paper No. 25). However, the proposed amendment introduced matter into the specification that does not seem to be supported by those portions of the specification where those limitations were introduced.

In a later amendment, filed on October 07, 2004 (the "instant amendment"), the applicant responded to the examiner's concerns above by pointing to portions of the specification that supported the claimed subject matter.

Applicant's arguments with respect to the phrases "independently accessible address", "separately...accessible" and "by anyone" are deemed persuasive. Accordingly, the 112, 1<sup>st</sup> paragraph rejections made against the use of these particular phrases are withdrawn.

However, applicant's arguments concerning the limitations "directly accessible" and "unique to the recorded audio file" were not considered persuasive and the rejections for those limitations are repeated below.

The applicant has attempted but failed to point out how these or other portions of the specification specifically support the matter introduced (e.g., see the rebuttal to the applicant's arguments above).

Further, the express support for these limitations is not apparent upon an inspection of the original disclosure, especially since the limitations are directed to strong and unequivocal language such as "directly accessible" and "unique".

The basis of such strong claim and unequivocal terminology should be reasonably presented and developed in the original disclosure, especially since it the applicant has and continues to argue that this terminology is what distinguishes the applicant's invention over the prior art.

A person of ordinary skill in the art at the time the application was filed would not have recognized that the inventor was in possession of the term "unique" as claimed because the portions of the specification that were pointed out by the applicant disclose terms that are substantially dissimilar and even have contradictory qualities, such as the term "corresponding" (see the examiner's rebuttal arguments on pages 1 and 2 above for further details).

A person skill in the art at the time the application was filed would not have recognized that the inventor was in possession of the term "directly accessible" as claimed in view of the disclosure of the application as filed because the applicant continues to argue that such a term must exclude certain steps before a user directly accesses the file via a hyperlink, such as gaining authorization and entering a file list command (see the examiner's rebuttal arguments on pages 3 and 4 above for further details). Such exclusions are wholly lacking from the applicant's specification.

*Specification*

The amendment filed on April 12, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: ""unique to the recorded audio file" and "directly accessible". Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections Using Choksi as a Base Reference***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 12-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,477,243 B1 to Choksi et al. ("Choksi"), of record.

With respect to claim 1, the following paragraphs for additional details on how Choksi discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a...[fax] recording device" reads on Figs. 1 and 6 where the transmitting fax 12 establishes a

telephony connection via PSTN 16 in order to establish a connection with computer 18 (fax recording device). See also col. 5, lines 5-12.

The limitation "b. recording...[a fax] communication transmitted over the telephony connection thereby establishing a recorded...[fax] file" reads on Fig. 6, steps 106 and 108 where the transmitted fax is received and stored on computer 18.

The limitation "c. associating an independently accessible address with the recorded...[fax] file, such that when the address is accessed using the computer system, the recorded...[fax] file is transmitted to the computer system for playback" reads on Choksi as follows. Upon receipt of the fax, an e-mail including the URL of a web page at which the stored fax message may be sent to the user (col. 8, lines 49-56). The user then may access the fax message by visiting the web page associated with the URL within the e-mail (col. 8, lines 56-67) which is consistent with the applicant's specification.<sup>1</sup> The phrase "independently accessible address" is extremely broad. For example, the URL (address) associated with the recorded fax file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded...[fax] file is separately and directly accessible by anyone using the independently accessible address" reads on Fig. 1 where the recorded fax is stored at a URL (as discussed above) accessible via the Internet 22 at virtually any location in the world. An URL (address) that is accessible via the Internet at virtually any location in the world

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can be considered a separately and independently accessible address by anyone. For example, an "independent" computer 24 is capable of "separately" "accessing" the recorded fax file somewhere else on the Internet. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the URL within the e-mail which is consistent with the applicant's specification as discussed above.<sup>2</sup>

The limitation "wherein the independently accessible address is unique to the recorded...[fax] file" reads on col. 7, line 65 – col. 8, line 2, col. 8, lines 53-55, and col. 10, lines 23-28 where the address "specifies" the location (web page) of the fax file via a URL address within a remote e-mail message. Therefore, the address is unique to the file otherwise it would not be able to specify (i.e., specific to) the location of the fax file via a remote e-mail.

Although Choksi discloses the processing of a recorded fax in the main embodiment as discussed above, Choksi fails to disclose in the main embodiment the recorded audio files are processed in the same manner. However, Choksi teaches in another embodiment that, in addition to processing fax files as discussed above, the system also processes voice messages (recorded audio files) (col. 9, lines 30-45).<sup>3</sup>

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<sup>1</sup> This interpretation is consistent with the applicant's specification, which states that an e-mail containing the address of the message is sent to the user (page 8, lines 17-22, and page 13, lines 8-10).

<sup>2</sup> Note that the applicant's specification fails to provide support for the terms "directly accessible" and "unique to the recorded file" as discussed above in the 35 USC 112 rejection. Nonetheless, examiner's interpretation is reasonably broad consistent with the applicant's specification as discussed above in the examiner's rebuttal to applicant's arguments.

<sup>3</sup> Note that there is little difference in context between the main embodiment (facsimile message reception station) and alternate embodiments (voice message reception station). For example, the context of providing notification that the message was successfully received that a message reception station in the alternate embodiment is also same context that the facsimile message reception station is used in the main embodiment contrary to applicant's arguments. Specifically, Choksi teaches in the main embodiment that the facsimile message reception station also

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the second embodiment supporting recorded audio files as taught by Choksi to the first embodiment disclosed by Choksi.

The suggestion/motivation for doing so would have been that Choksi teaches that the "present invention should in no way be limited" to the main embodiment but instead additionally support recorded audio files (col. 9, lines 30-45).<sup>4</sup> In addition, it would have been facially obvious to one of ordinary skill in the art, upon inspecting single patent containing two embodiments, to have incorporated compatible features from one embodiment into the other embodiment because both embodiments are disclosed in the same document to the person of ordinary skill.

Claim 12 differs substantively from claim 1 in the following addition limitation "notification is sent to a recording user responsible for recording the audio communication, the notification specifying..." which reads on the transmittal of the e-mail containing the URL to the recording user as discussed in the claim 1 rejection above.

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notifies the sender that the message has been successfully received (abstract). The notification is an e-mail that includes the independently accessible address as consistent with the applicant's specification and as discussed in footnote 1.

<sup>4</sup> Specifically, Choksi concentrates on an automated facsimile message system in the main embodiment but then states "the present invention should in no way be limited thereby" and that "in addition to the above-described embodiments, a...voice...system configured in accordance with the present invention may include a message reception station configured to receive voice...messages...and to notify each sender therefor of the successful

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on the transmittal of e-mail message (second file) which includes the file (col. 8, lines 40-58) modified to include the audio file (see the claim 1 rejection).

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection..." reads on Fig. 1, telephone 29. The limitation "b. means for recording...." and "c. means for storing..." reads on Fig. 1, computer 18.

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. See also Figs. 1 and 5 which illustrate the various circuits and systems to perform the functions recited in the claim. See the claim 22 rejection for further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. Further, the limitations "a. a call processing and recording system" reads on Fig. 5, fax message 44 and "b. a server coupled to the call processing and recording system"

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receipt...of a message (col. 9, lines 30-41) (emphasis added) (i.e., via e-mail notification as done in the facsimile

reads on Fig. 5, e-mail notification server 50. The limitation "c. one or more computer systems" reads on Figs. 1 and 5. Note that the above components have been modified to support recorded audio files (see the claim 1 rejection).

With respect to claim 44-47, see the claims 1, 22, 30, and 37 rejections respectively plus the claim 12 rejection for further details.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Bobo where the message is played back to each of the one or more users who uses the URL to received the recorded audio file.

Claim 49 differs substantively from claim 1 in that it is more broadly recited. Therefore, see the claim 1 rejection for further details.

With respect to claims 2 and 18, see Fig. 5.

With respect to claims 3, 8, and 20, see col. 8, lines 60-67. Entry of a PIN would require a user profile to recognize the PIN.

With respect to claims 4, 5, 9, 13, 33, and 42, see the claims 1 and 37 rejections for further details.

With respect to claims 6, 29, 36, and 43, although Choksi discloses sending the URL in the e-mail as discussed above, Choksi fails to disclose that the e-mail is in the form of a hyperlink.

However, "Official Notice" was taken in the last Office action that both the concept and advantages of including hyperlinks in e-mail would have been well known and expected in the art. The applicant's lack of traverse to the officially noticed fact in the last Office action (i.e., the response) is taken as an admission of the facts noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a hyperlink to the e-mail comprising the URL as disclosed by Choksi.

The suggestion/motivation for doing so would have been to integrate the e-mail system with browsing capability and thus increase user-friendliness, efficiency and flexibility so that the user can directly launch a browser for the address corresponding to a particular URL address (i.e., eliminate browser launching and address selection steps) by simply clicking on a hyperlink within the e-mail as is notoriously well-known in the art.

With respect to claims 7, 18, 19, 23-28, 32, 34, 35, and 39-41, see Fig. 1.

With respect to claim 14, the link (URL) is posted in the e-mail (predetermined location).

With respect to claim 15, see col. 8, lines 60-67.

With respect to claim 16, although Choksi discloses that the user is provided descriptive information regarding the message (col. 8, lines 49-67), Choksi fails to specifically disclose that this information include the title.

However, "Official Notice was taken in a prior Office action that both the concept and advantages of including the "title" in descriptive information about a file would have been well-known and expected in the art. The applicant's lack of traverse to the officially noticed fact in the prior Office action (i.e., the response) is taken as an admission of the facts noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add "title" to the descriptive file information disclosed by Choksi.

The suggestion/motivation for doing so would have been to quickly convey salient and easily remembered information about the file such as title as is notoriously well known in the art.

With respect to claim 21, see the claim 12 rejection above.

With respect to claims 31 and 38, see Fig. 5, archive 48.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choksi as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 5,809,512 to Kato ("Kato"), as used in the last Office action.

Choksi fails to disclose that the user or a location profile specifies a time where the recorded file is available for playback after a delay period.

However, Kato (similarly to Choksi) teaches of a multimedia message storage system (abstract) where the user specifies a delay period for posting (available for playback) using a stored, predetermined schedule (location profile) or manually (col. 75, lines 13-25, col. 76, lines 7-52, and col. 77, lines 1-5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made the add the ability for the user to specify a delay using location profile or manually as taught by the message storage system of Kato to the message storage system of Choksi.

The suggestion/motivation with respect to a location profile would have been to increase the flexibility, versatility and efficiency and to reduce the cost of the message storage system by

allowing the user to individually determine time periods in accordance with utilization conditions, CPU performance capabilities, and cost (Kato, col. 76, lines 18-52). In addition, flexibility would have been increased by allowing the user to determine posting time such as when the user has an urgent need to post the message immediately.

***Claim Rejections Using Bobo as a Base Reference***

***Claim Rejections - 35 USC § 103***

Claims 1-7, 9, 13-19, 22-43, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,675,507 to Bobo, II ("Bobo"), as used in the last Office action, in view of U.S. Patent No. 6,408,296 B1 to Acharya et al. ("Acharya"), as used in the last Office action.

With respect to claim 1, the following paragraphs for additional details on how Bobo discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a call recording device" reads on Figs. 1 and 2, where a telephone call (telephony connection) is established between Telephone Set 26 (telephony device) and a call recording device (Message Storage and Delivery System) (MSDS 10).

The limitation "b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file" reads on Fig. 2, step 52 where the voice message is recorded and stored.

The limitation "c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio file is transmitted to the computer system for playback" reads on Bobo as follows. The user accesses the voice message (recorded audio file) on the computer system by selecting the anchor (col. 13, lines 5-33). The anchor (hyper-text link) points to address where the file (e.g., voice message) is stored (e.g., <A HREF=1.wav") (col. 8, lines 8-20, col. 12, lines 30-54, and col. 13, lines 1-33). Therefore, the address is accessed using the computer system when the user selects the anchor (hypertext link) which points to the address of the recorded file consistent with the applicant's specification.<sup>5</sup> The phrase "independently accessible address" is extremely broad. For example, the URL (address) associated with the recorded audio file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded audio file is separately and directly accessible by anyone using the independently accessible address" reads on col. 18, lines 35-56 where the recorded audio file is accessible via the WWW at "virtually any location in the world". An URL (address) that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address by anyone. For example, an "independent"

computer is capable of "separately" "accessing" the recorded audio file somewhere else on the WWW. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the anchor (hyperlink) consistent with the applicant's specification as discussed above.<sup>6</sup> The existence of a possible authorization requirement does not restrict anyone from accessing the address when that authorization information is shared, such as when families or business associations share joint access to information of shared interest.

Although Bobo discloses that the address is independently accessible as discussed above, Bobo fails to specifically disclose that the address is "unique to the recorded audio file."

However, Bobo teaches that the hyperlink points to as address as discussed above. The address represents the location of the file on a computer connected to the Internet. If the address was not unique to the file, then the user would have difficulty locating and retrieving the file after selecting the hyperlink. Further, a web hyperlink allows the user to expressly spell out the full path of the recorded file. That is, the user can specify the content of the hyperlink without structural modification to reflect the full path (address) unique to the recorded file. Therefore, Bobo strongly suggests that the content of the hyperlink (address) would have been unique to the file in order to successfully locate and retrieve the file.

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<sup>5</sup> This interpretation is consistent with the applicant's specification, which states that the user accesses the address where the recorded file is stored by "selecting a hyperlink pointing to the address" (page 4, lines 14-16, page 8, lines 17-22, and page 13, lines 12-14).

<sup>6</sup> See footnote 2.

Nonetheless, Acharya teaches of a web system where a "each traditional hyperlink is associated with a single URL, each hyperlink is associated with a single file having a particular location on a particular server" (i.e., the address) (col. 1, lines 35-47). Therefore, Acharya teaches that each hyperlink points to an address unique to the recorded audio file.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability of the hyperlink to point to an address unique to the recorded audio file as taught by the web access system of Acharya to the web access system of Bobo where the hyperlink points to an address of the recorded file.

The suggestion/motivation for doing so would have been to increase the efficiency and reliability of recorded file retrieval. Specifically, if the hyperlink did not point to an address unique to the recorded file, then the system of Bobo would have had difficulties reliably locating and retrieving the recorded file. Further, the prior art recognizes that it is "traditional" for a hyperlink to point an address unique to a file (Acharya, col. 1, lines 44-50). Finally, Bobo provides the capability (no structural modification required) for the user to specify the content of the hyperlink to reflect the full path (address) unique to the recorded file as discussed above. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). In this way, owners of the patented prior art devices are

protected when using their devices as they see fit. Here, the content of the prior art hyperlink structure of Bobo is able to perform the intended use of identifying a unique address for the file as discussed above. Therefore, Bobo as modified meets the claim requirements.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on Bobo as discussed above where the recorded file is included in a second file such as "1.wav" that is accessed via an html file containing the anchor (hyperlink) (first file).<sup>7</sup> See the claim 1 rejection for additional details.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection..." reads on Fig. 1, Telephone Set 26. "[B]. Means for recording...." and "c. means for storing..." reads on Fig. 1, MSDS (10).

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. Further, the limitations "a. a call processing and recording system" reads on Fig. 13, Central Processor (3) and "b. a server coupled to the call processing and recording system" reads on Fig. 13, Internet Server 5. Note that Fig. 13 illustrates the various systems that comprise MSDS 10. See also col. 16, lines 47 – 67. The limitation "c. one or more computer systems" reads on Fig. 1, Computer 32.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Bobo where the message is played back to each of the one or more user who logs into the mailbox with the appropriate ID and password.

Claim 49 differs substantively from claim 1 in that it is more broadly recited. Therefore, see the claim 1 rejection for further details.

Claim 50 differs substantively from claim 1 in that the recording processing includes selecting from a group consisting of transmitting, playing back, editing and re-recording the recorded audio file. Bobo also teaches transmitting the recorded audio file. Bobo also discloses playing back and re-recording the recorded file (Fig. 11 and col. 14, lines 1-15). Re-

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<sup>7</sup> Note that this interpretation is also consistent with the applicant's specification which also indicates that including the audio file within a second file such as a web page or e-mail may be accomplished by including a hypertext link (anchor) to a recorded file (Fig. 6, step 152 and page 16, lines 24-28).

recording the file and then choosing to save the re-recorded file would be an "editing" function performed on the file.

With respect to claim 2, see Fig. 13, Internet Server 5 and col. 17, lines 37-43.

With respect to claim 3, see Fig. 8 and col. 12, line 63 – col. 13, line 23. Note that the address (URL) is accessed when the audio file is retrieved.

With respect to claims 4, 28, and 42, see col. 13, lines 10-15 where the user selects an anchor (hyperlink) to access a voice message (audio file). Although the anchor (hyperlink) may be a simple HREF command referring to the voice message (audio file), selecting the hyperlink would still result in the html address (URL) corresponding to user's mailbox on the Internet Server 5 being sent to Internet Server 5 in order for the browser to request and retrieve the voice message (audio file) from Internet Server 5.

With respect to claims 5, 25, 26, 33, and 34, see Fig. 1 where an Internet (data) connection is established between the Computer 32 and the MSDS 10 in order to play back recorded audio (col. 12, line 63 – col. 13, line 33).

With respect to claims 6, 29, 36, and 43, see col. 13, lines 10-15 and the claim 4 rejection above.

With respect to claims 7, 24, 32, and 39, see Fig. 13 where the Internet Server 5 (server) is remote from the Computer 32 (computing system).

With respect to claim 9, the message storage process of Fig. 2 and message retrieval process of Fig. 3 are separated by time. The phrase "recorded audio file is first available for playback" is a broad term. For example, an audio file may be only considered "available" to the user when the user has established and Internet connection and successfully logged onto the MSDS 10 by entering a correct logon id and password. If the user is unable to log onto the MSDS 10, then the audio files are "unavailable" to the user.

With respect to claim 13, see col. 8, lines 10-20 and col. 13, lines 16-18.

With respect to claim 14, the link is posted in a predetermined location, namely in the MSDS 10.

With respect to claim 15, see col. 13, lines 13-14.

With respect to claim 16, see Table 1 (col. 12, lines 30-53).

With respect to claim 18, the web server would serve the html file and anchored audio file (step of including is performed by a server).

With respect to claim 19, see Fig. 13 where the Internet Server 5 (server) is remote from the Computer 32 (computing system).

With respect to claims 23, 31, and 38, see Fig. 15, Storage (11).

With respect to claim 27, see Fig. 13, Internet Server (5).

With respect to claim 35, see Fig. 15, Storage (11) where the html files are addressed via the Internet (30).

With respect to claim 40, see col. 6, lines 20-22.

With respect to claim 41, see Fig. 1.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo in view of Acharyra as applied to claims 1 and 9 above, and further in view of Kato.

Bobo fails to disclose the limitations within claims 10 and 11 however this would have been an obvious addition as taught by Kato. See the Choksi in view of Kato rejection above for further details regarding the obviousness of adding the teachings of Kato.

***Claim Rejections Using Uppaluru as a Base Reference***

***Claim Rejections - 35 USC § 102***

Claims 1, 8, 17, 20, 22, 30, 37, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 5,915,001 to Uppaluru ("Uppaluru"), as used in the last Office action, in view of Acharya.

Uppaluru teaches of a system for providing speech files that are accessible via the Internet. Significantly, Uppaluru also teaches of allowing users to make the speech files accessible (publishing the speech files) using a telephonic connection.

With respect to claim 1, the following paragraphs for additional details on how Uppaluru discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a call recording device" reads on col. 20, lines 4-10.

The limitation "b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file" reads on col. 21, lines 10-13.

The limitation "c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio file is transmitted to the computer system for playback" reads on Uppaluru as follows. A URL

(address) is associated with the recorded audio files (col. 21, lines 25-29 and col. 7, lines 13-67). The URL can then be accessed telephonically (col. 7, lines 28-39) or via a WWW browser (col. 7, lines 20-21) via hyperlinks (abstract). The hypertext link points to address where the file (e.g., voice message) is stored (e.g., <A HREF="myweb/home/prompts.vml#prompt1") (Appendix A). Therefore, the address is accessed using the computer system when the user selects the hypertext link which points to the address of the recorded file.<sup>8</sup> The phrase "independently accessible address" is extremely broad. For example, the URL address of Uppaluru associated with the recorded audio file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded audio file is separately and directly accessible by anyone using the independently accessible address" reads on Uppaluru as follows. The recorded audio file is accessible via the WWW using a conventional web browser (col. 7, lines 20-23) which means the file is accessible at virtually any location in the world. An address that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address by anyone. For example, an independent computer is capable of "separately" "accessing" the recorded audio file somewhere else on the WWW. As

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<sup>8</sup> This interpretation is consistent with the applicant's specification, which states that the user accesses the address where the recorded file is stored by "selecting a hyperlink pointing to the address" (page 4, lines 14-16, page 8, lines 17-22, and page 13, lines 12-14). This interpretation is also consistent with the term "computer system", which is broad and certainly means more than merely a web browser. In this case, the term "computer system" is interpreted as the voice browser computer, where the recorded audio file is transmitted to the computer system (voice browser) for playback to the user via a telephonic connection.

for being "directly" accessible, the user "directly" accesses the recorded file by selecting the anchor (hyperlink) (abstract) consistent with the applicant's specification as discussed above.<sup>9</sup>

Although Uppaluru discloses that the address is independently accessible as discussed above, Uppaluru fails to specifically disclose that the address is "unique to the recorded audio file."

However, Uppaluru teaches that the hyperlink points to an address which certainly appears unique to the file as discussed above. The address represents the location of the file on a computer connected to the Internet. If the address was not unique to the file, then the user would have difficulty locating and retrieving the file after selecting the hyperlink. Further, a web hyperlink allows the user to expressly spell out the full path of the recorded file. That is, the user can specify the content of the hyperlink without structural modification to reflect the full path (address) unique to the recorded file. Therefore, Uppaluru strongly suggests that the content of the hyperlink (address) would have been unique to the file in order to successfully locate and retrieve the file.

Nonetheless, Acharya teaches of a web system where a "each traditional hyperlink is associated with a single URL, each hyperlink is associated with a single file having a particular location on a particular server" (i.e., the address (col. 1, lines 35-47). Therefore, Acharya teaches that each hyperlink points to an address unique to the recorded audio file.

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<sup>9</sup> See footnote 2.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability of the hyperlink to point to an address unique to the recorded audio file as taught by the web access system of Uppaluru to the web access system of Bobo where the hyperlink points to an address of the recorded file.

The suggestion/motivation for doing so would have been for the same reasons that Acharya was an obvious addition to Bobo. Therefore, see the claim 1, Bobo in view of Acharya rejection for further details.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on Uppaluru as discussed above where the recorded file is included in a second file such as "prompt.vml" that is accessed via an html file containing the anchor (hyperlink) (first file).<sup>5</sup> See the claim 1 rejection for additional details.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection" reads on Fig. 1, Telephone Set 111. The limitation "b. means for recording" reads on Fig. 1, Voice and

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Telephony Interface 114 and col. 6, lines 23-30. The limitation c. means for storing" reads on Fig. 1, Voice Web Site 102.

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. "a. a call processing and recording system..." reads on Fig. 1, Voice and Telephony Interface 114. "b. a server coupled to the call processing and recording system..." reads on Fig. 1, Voice Web Site 102.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Uppaluru where the message is played back to each of the one or more user who log onto the voice web system.

Claim 49 differs substantively from claim 1 in that it is more broadly recited. Therefore, see the claim 1 rejection for further details.

With respect to claim 8, see col. 1, lines 33-67.

With respect to claim 20, see col. 1, lines 33-67.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

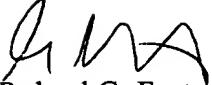
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster  
Primary Patent Examiner  
February 18, 2005